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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,240	08/01/2003	Roy Wong	56494US010	2455

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3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER
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PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/633,240

Applicant(s)

WONG, ROY

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 40-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 40-42 is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-14-05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Specification***

The amendment in response to the Objection to the Specification of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objection.

#### ***Claim Objections***

The amendment in response to the Claim Objection of the Previous Office Action is acknowledged and appreciated, and the Examiner withdraws the objection.

#### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,5,10,11,13,16,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rabuse et al US 3347362.

Rabuse et al is cited for the same reasons previously discussed, which are incorporated herein. Applicants remarks have been carefully considered.

Applicants argue Rabuse does not teach contacting the tape edge with a “non-free radically curable composition”. While this express language is not used, the Examiner points out (1) the edge coating materials are non-free radically curable compositions as described by Applicants on page 4, bottom, of their Specification; that is the compositions of Rabuse do not require radiation and chemical crosslinking, and (2) the edge coating materials of Rabuse include “soft plastic or waxy organic composition” (col. 2, 47-48) which dry to form a firmly adhered edge coating. The Examiner notes Applicants coating materials cite such waxes at least on page 4, line 5 and claim 5. Thus, the coating materials of Rabuse would inherently possess the same property requirements as the same claimed coating materials of Applicants, meeting the

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limitation of being “non-free radically curable compositions”. Applicants also appear to dispute the coating of Rabuse for “detackifying an edge” of the tape. The Examiner notes this limitation is simply in the preamble and there is no nexus between this limitation of the preamble and the method steps, so the limitation is not required to be given patentable weight. Nonetheless, the Examiner points out Rabuse states on column 3 that the applied coatings, upon drying, provide “so that the material will not separate from the edges of the tape, will not peel or flake, and will not form a rough or ragged edge on the unwound tape.” Similarly, Applicants on page 4, line 9+ describe their coating “upon drying” as having the ability of forming an adherent coating to the tape which “does not visibly crumble, form particles, or otherwise fall off the edge face of the...tape”, and further so edge faces to not stick to one-another. Again it is noted Rabuse and Applicants cite the same waxy organic coating materials. Hence, while the coating of Rabuse is not expressly labeled as a coating for detackifying an edge face, clearly the descriptions of the reference of the formed edge coatings describe the inherency of the coatings as providing for detackifying an edge face.

While Rabuse may cite the coatings as being anti-static, Applicants arguments of their coatings being non-tacky are at best an observation of another benefit resulting from a suggestion provided by the prior art as cited above, which does not establish a basis of patentability, *In re Woodruff*, 16 USPQ2d 1934; *In re Swinehart*, 169 USPQ 226-229.

Rabuse therefore meets all the claim limitations and Applicants arguments are not persuasive.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Swanson et al WO00/78882.
4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al.
5. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Hawley's.
6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Koshar et al.
7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Larimore et al US 4751108.
8. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabuse et al in view of Kantner et al US 5536768.

The references and rejections are cited for the same reasons discussed in the previous Office Action, which are incorporated herein. Applicants remarks have been carefully considered.

The response to Applicants remarks relative to the rejections under 35 USC 103 are combined because Applicants' arguments are essentially the same: Applicants' premise is that since they have refuted the rejection of the claims under 35 USC 102, the claims under 35 USC 103 cannot stand, and the rejections under this heading should be withdrawn. No additional reasons for refuting the rejections are provided.

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The Examiner maintains the rejections of claims 1,5,10,11,13,16,17 under 35 U.S.C. 102(b) as being anticipated by Rabuse et al, and hence the rejections under 35 USC 103 are also maintained for the same reasons previously cited. Examiner notes claims 40-42 remain allowable.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

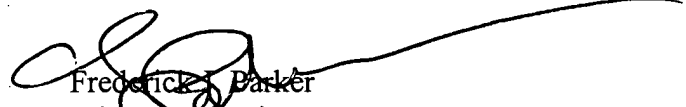
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp